

### **REMARKS**

The Official Action mailed January 11, 2010, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on September 25, 2006; April 18, 2007; June 23, 2009; and October 15, 2009.

Claims 1-22 were pending in the present application prior to the above amendment. Claims 1-22 have been canceled without prejudice or disclaimer, and new claims 23-43 have been added to recite additional protection to which the Applicant is entitled. Accordingly, claims 23-43 are now pending in the present application, of which claims 23 and 43 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action objects to the abstract and asserts that "the word 'means' must be avoided" (page 2, Paper No. 20091215; emphasis added). The Applicant respectfully disagrees and traverses the assertions in the Official Action. MPEP § 608.01(b) merely states that "[t]he form and legal phraseology often used in patent claims, such as 'means' and 'said,' should be avoided" (emphasis added). As such, the term "means" may appear in an abstract. The Applicant respectfully submits that the abstract, as filed, sufficiently describes the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details. Accordingly, reconsideration and withdrawal of the objections are in order and respectfully requested.

The Official Action objects to claims 5, 10, 12, 14 and 19 asserting that "they can not depend from a claim that has alternative dependency" (Id.). The Applicant respectfully disagrees and traverses the assertions in the Official Action. Rule 75 merely states that "[a] multiple dependent claim shall not serve as a basis for any other

multiple dependent claim.” That is, a multiple dependent claim cannot depend from another multiple dependent, but it is entirely permissible for a singly dependent claim to depend from a multiple dependent claim. See MPEP § 608.01(n). In any event, claims 5, 10, 12, 14 and 19 have been canceled without prejudice or disclaimer; therefore, the above-referenced objection is now moot.

The Official Action rejects claims 1-3, 16-18 and 20-22 as anticipated by JP 2002-340596 to Harada. The Applicant respectfully submits that an anticipation rejection cannot be maintained against the new independent claims of the present application.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claims 1-22 have been canceled without prejudice or disclaimer, and new claims 23-43 have been added to better recite the features of the present invention and to more clearly define the technical features of the present invention. Specifically, claims 23-43 are directed to a facility searching device comprising, among other features, a feature whereby if a voice input is provided for a genre name of facilities (an affirmative decision by a first decision unit) is made and if a pointing input for pointing to a road on a map, by movement of a point position with a predetermined distance from the road (an affirmative decision by a second decision unit) is made, and both are made within a predetermined time, then a search is implemented for facilities which belong to the genre and exist along the road or within a predetermined distance from the road.

These features are advantageous for at least the following reasons: it is possible to implement the search of the facilities belonging to the genre and existing along the road or within a predetermined distance from the road by merely pointing or dragging to a road on a map while uttering a genre name. For the reasons provided below, the

Applicant respectfully submits that Harada does not teach the above-referenced features of the present invention, either explicitly or inherently.

Harada might generally disclose a search for facilities based on a position and genre. However, in Harada, a search is implemented, for example, in an area near a current position. This is different from the present invention in which a search is implemented for facilities existing along a road on a map or within a predetermined distance from the road if an input pointing to the road is made by moving a point position within the predetermined distance from the road.

Therefore, the Applicant respectfully submits that Harada does not teach all the features of the present independent claims, either explicitly or inherently.

Since Harada does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 4, 5, 8-13 and 19 as obvious based on the combination of Harada and JP 2001-184359 to Takahashi. The Official Action rejects claims 6 and 15 as obvious based on the combination of Harada and JP 2002-055989 to Yase. The Official Action rejects claims 7 and 14 as obvious based on the combination of Harada and JP 2003-203075 to Kawabata. The Applicant respectfully submits that a *prima facie* case of obviousness cannot be maintained against the new independent claims of the present application.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the

prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Harada. Takahashi, Yase or Kawabata does not cure the deficiencies in Harada. The Official Action relies on Takahashi, Yase or Kawabata to allegedly teach the features of the previously pending above-referenced dependent claims, i.e. the Official Action relies on Takahashi to allegedly teach, e.g., "the start point and end point of a search line together with the distance from the search line" (page 3, Paper No. 20091215), on Yase to allegedly teach, e.g., "that range specification is carried out on a map by specifying a polygonal range ... using a mouse" (page 4, Id.) and on Kawabata to allegedly teach, e.g., "that when specifying a search range on a map, two points are specified on a map, and a circle having these points as the diameter is made to serve as the range, and the center of this circle is the intermediate position between the two points" (page 5, Id.).

Specifically, in Takahashi, an area from a designated start point to a designated distance is set as an area to be searched so that an area along a road can be searched; however, this is different from the present invention in which a search is implemented for facilities existing along a road on a map or within a predetermined distance from the road if an input pointing to the road is made by moving a point position within the predetermined distance from the road.

Yase discloses designating a rectangular area, a polygon area or a circle area as a method of designating an area to be searched, but Yase does not teach or suggest designating a road, as in the present invention.

In Kawabata, an object along a road is clicked, and this object is what is to be searched. However, Kawabata does not teach or suggest a search for facilities existing along a road on a map or within a predetermined distance from the road if an input pointing to the road is made by moving a point position within the predetermined distance from the road. In Kawabata, it is difficult to ensure the designation of a road, for example, in a situation where roads intersect. Also, by designating with a click, an additional operation is required to distinguish it from the designation of a center point of an area to be searched. In contrast, in the present invention, a road is designated by moving a point position within a predetermined distance from the road; therefore, it is possible to decide, without an additional operation, that the moving operation is to designate the road and to certainly and easily designate the road.

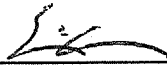
Therefore, Harada and Takahashi, Yase or Kawabata, either alone or in combination, do not teach or suggest that Harada should be modified to include at least the following features of the new independent claims: a feature whereby if a voice input is provided for a genre name of facilities (an affirmative decision by a first decision unit) is made and if a pointing input for pointing to a road on a map, by movement of a point position with a predetermined distance from the road (an affirmative decision by a second decision unit) is made, and both are made within a predetermined time, then a search is implemented for facilities which belong to the genre and exist along the road or within a predetermined distance from the road.

Since Harada and Takahashi, Yase or Kawabata do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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